

REMARKS

The present application was filed on December 4, 2000 with claims 1-27. Claims 1-28 are pending in the present application and claims 1, 11, 14, 18 and 28 are the pending independent claims.

Applicants again request that the Examiner change the filing date of the application to December 4, 2000 in accordance with the documentation provided in the response of July 21, 2004. Should these documents be insufficient to support a change of the filing date, Applicants again request information from the Examiner as to what is required to effect such a change.

In the outstanding final Office Action dated March 8, 2006, the Examiner: (i) rejected claims 1-3, 5, 7, 8, 10, 11, 13-20, 22, 24, 25 and 28 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,473,778 to Gibbon (hereinafter "Gibbon") in view of U.S. Patent No. 6,654,030 to Hui (hereinafter "Hui"); (ii) rejected claims 4, 12 and 21 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Hui and U.S. Patent No. 4,570,221 to Martens (hereinafter "Martens"); (iii) rejected claims 6 and 23 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Hui and U.S. Patent No. 6,397,219 to Mills (hereinafter "Mills"); and (iv) rejected claims 9 and 26 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Hui and U.S. Patent No. 6,317,151 to Ohsuga et al. (hereinafter "Ohsuga").

Applicants respectfully request reconsideration of the present application in view of the following remarks.

With regard to the rejection of claims 1-3, 5, 7, 8, 10, 11, 13-20, 22, 24, 25, 27 and 28 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Hui, Applicants respectfully assert that the cited combination fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a), as specified in M.P.E.P. §2143.

As set forth therein, M.P.E.P. §2143 states that three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a

prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that no motivation or suggestion exists to combine Gibbon and Hui in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a prima facie case of obviousness has not been established.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In *re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” *Id.* at 1343-1344.

In the Office Action, on page 3, paragraph 1, the Examiner provides the following statement to prove motivation to combine Gibbon and Hui, with emphasis supplied:

“It would have been obvious . . . to modify Gibbon’s disclosed system to incorporate the teachings of Hui by using the XML-based format instead of using the HTML representation. . . . because one . . . would be motivated to allow users to easily understand and edit media contents.”

Applicants submit that the statement above is based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

It is well-settled law that “teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by Gibbon and Hui in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d

1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner's conclusory statements do not adequately address the issue of motivation to combine references. "It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

Secondly, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Gibbon and Hui. For at least this reason, a prima facie case of obviousness has not been established. Applicants do not believe that Gibbon and Hui are combinable since it is not clear how one would combine them. No guidance was provided in the Office Action as to how the references can be combined to achieve the present invention. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Lastly, the collective teaching of Gibbon and Hui fails to suggest or render obvious at least the elements of independent claims 1, 11, 18 and 28 of the present invention. For at least this reason, a prima facie case of obviousness has not been established.

Independent claim 1 recites a method of processing rich media content. A multimedia content file is created from rich media content as a first input to an authoring tool. A text based rich media content description file is created as a second input to the authoring tool. The description file comprises user-specified vocabulary that defines rich media content and relationships between rich media content, allowing a user to format the multimedia content file. The multimedia content file and the text based description file are combined in accordance with the user-specified vocabulary to create a composed file using the authoring tool for execution on a multimedia player. Independent claims 11, 18 and 28 recite similar limitations.

Gibbon discloses a rendering engine that processes multimedia descriptors and applies a template set to create an HTML representation. However, as acknowledged by the Examiner, Gibbon fails to disclose a text based rich media content description file having a user-specified vocabulary that defines rich media content and relationships.

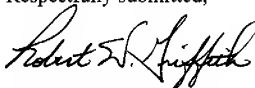
Hui discloses a synchronized multimedia integration language (SMIL) source file portion. While the SMIL source file specifies video statements that are to be executed in parallel and sequentially, it fails to disclose anything regarding a user-specified vocabulary defining rich media content and relationships between rich media content, which allows a user to format a multimedia content file. Thus, Hui fails to remedy the deficiencies of Gibbon described above, and the combination of Gibbon and Hui fails to disclose the combination of a multimedia content file and such a text based rich media content description file, comprising a user-specified vocabulary, to create a composed file for execution on a multimedia player, as described in the independent claims of the present invention.

Dependent claims 2, 3, 5, 7, 8, 10, 13-17, 19, 20, 22, 24, 25 and 27 are patentable at least by virtue of their respective dependency from independent claims 1, 11 and 18, and also recite patentable subject matter in their own right. Accordingly, withdrawal of the rejection of claims 1-3, 5, 7, 8, 10, 11, 13-20, 24, 25, 27 and 28 under 35 U.S.C. §103(a) is therefore respectfully requested.

With regard to the rejection of claims 4, 6, 9, 12, 21-23 and 26 under 35 U.S.C. §103(a) as being unpatentable over Gibbon and Hui in view of numerous respective tertiary references, Applicants assert that such claims are patentable for at least the reason described above with regard to Gibbon and Hui. The combination of Gibbon and Hui with one or all of the tertiary references fails to disclose, suggest or render obvious a description file that comprises a user-specified vocabulary that defines media content and relationships between media content, for rich media content processing, allowing a user to format a multimedia content file. The combination also fails to disclose, suggest or render obvious the combination of a multimedia content file and such a text based rich media content description file, comprising a user-specified vocabulary, to create a composed file for execution on a multimedia player. Further, dependent claims 4, 6, 9, 12, 21-23 and 26 are patentable at least by virtue of their respective dependency from independent claims 1, 11, 14 and 18, and also recite patentable subject matter in their own right. Accordingly, withdrawal of the rejections of claims 4, 6, 9, 12, 21-23 and 26 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicants believe that claims 1-28 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Griffith". The signature is fluid and cursive, with the first name "Robert" and last name "Griffith" clearly distinguishable.

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